

REMARKS

Claims 1 to 64 are pending.

§ 102/103 Rejections

Claims 1-3, 5, 6, 8, 10, 11, 16, 17, 20, 24, 25, 29-31, 33, 34, 36, 38-42, 46, 47, 52-55, 57, 58, 62 and 63 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Shiba et al. (U.S. Pat. No. 6,080,480).

The Patent Office asserts that Shiba et al., taken in light of applicants' admissions in the specification concerning the reference and its disclosed adhesive compositions at page 8, lines 29 and 30, either inherently anticipates or renders obvious at least some of applicants' claims, including each of the three independent claims. The Patent Office further asserts that the reference discloses what Applicants' specification teaches, particularly at page 7, lines 5-17, are certain of his preferred electrostatic or electret charge film backings, such as polyolefins including polyethylene and polyesters including PET, both taught as being suitable for being coated with the aforementioned heat activatable adhesive composition(s) which can later be activated if desired during usage, which the Patent Office asserts is essentially all that Applicants' broad article claims 1 and 53, together with method of use claim 29, require. Regarding performance parameters relating to the adhesive activation and the accompanying gel content (i.e. measure of crosslinking) of the adhesive, the Patent Office further asserts that these are to either inherently exist in the aforementioned "preferred adhesives" or alternatively be at most an obvious optimization thereof.

Without agreeing to the Patent Office's characterization of Shiba et al., or admitting that the rejection is even proper, and upon further reading of Shiba et al., Applicants bring it to the Examiner's attention that in the Examples of Shiba et al. (in col. 8, lines 40-44) heat activatable adhesive is coated onto a polyester film that has a corona treatment. Applicants concede that some corona treatments impart electrostatic (e.g., electret) properties to some polymer films. Notwithstanding this, however, it is submitted that such corona treatment for the purpose of modifying surface energy of polymers is common and does not necessarily lead to a cling

backing. Similarly, the mere recitation of various polymer backings does not necessarily make them "cling backings" within the meaning of Applicants' application.

In Applicants' specification on page 5, lines 11-12, the term "cling backing" is defined as "a backing that can cling to a substrate without the use of adhesives or fasteners". The American Heritage Dictionary, Second College Edition, Houghton Mifflin Company, Boston, ©1982, on page 281 (appended hereto as "Attachment A") defines the word "cling" as:

1. To hold fast or adhere to something, as by grasping, sticking, embracing, or entwining. 2. a. To stay near; remain close. b. To fit closely, as to the body: fabrics that cling. c. To resist separation. 3. To hold on; remain attached: *cling to old-fashioned ideas*.

Clearly, films of the polymers recited in Shiba et al. are widely known that do not have cling properties within the ordinary meaning of the term "cling". The Patent Office is again reminded that just because two films have a superficially identical chemical composition, it does not imply that they necessarily have identical cling properties. Applicants refer to their detailed remarks concerning this point that may be found in their previous two Amendments (dated 8/10/05 and 12/28/05).

In order to support an inherency rejection under § 102, it is necessary that the reference disclosure relied upon inherently (i.e., always) has the property (e.g., "cling") in question; for example, MPEP (4th Ed.) in Section 2112, IV., page 2100-57, states:

"The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Hence, it is submitted that Shiba et al. fails to properly anticipate (e.g., by inherency) the subject matter of at least claims 1, 29 and 53.

Regarding the issue of obviousness, Applicants submit that Shiba et al. is directed toward a solution of the problem of premature adhesion and blocking that occurs with adhesives (e.g., see Shiba et al. in col. 7, lines 23-55 and especially lines 23-24 (non-tacky) and 48-49 (excellent in blocking resistance)) prior to activation of the heat activatable adhesive. Applicants further submit that one of ordinary skill in the art would not be properly motivated to increase adhesiveness of the heat activatable article of Shiba et al. (e.g., by using a cling backing) prior to activation, since Shiba et al. essentially teach away from increasing adhesion. absent hindsight reasoning based on Applicants' own disclosure. Hence, claims 1, 29 and 56 are non-obvious in view of Shiba et al.

Claims 1 and 29 (and 56) are patentable for at least the reasons given above. Claims 2-3, 5, 6, 8, 10, 11, 16, 17, 20, 24, 25, 30-31, 33, 34, 36, 38-42, 46, 47, 52-55, 57, 58, 62 and 63 each add additional feature(s) to patentable claims and are likewise patentable.

In summary, the rejection of claims 1-3, 5, 6, 8, 10, 11, 16, 17, 20, 24, 25, 29-31, 33, 34, 36, 38-42, 46, 47, 52-55, 57, 58, 62 and 63 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Shiba et al. has been overcome and should be withdrawn.

Claims 1-3, 5, 6, 10, 11, 16, 17, 20, 24, and 25 stand rejected under 35 U.S.C. § 102(b) as anticipated by or in the alternative, under 35 U.S.C. § 103(a) as obvious over WO '540 (WO 96/08540).

The Patent Office asserts, in light of Applicants' admissions in the specification concerning its adhesive composition at page 8, lines 30-31, that WO '540 inherently anticipates, or alternatively renders obvious a significant number of the claims of the claimed invention. The Patent Office asserts that the paragraph bridging pages 4 and 5 of WO '540 teaches that such tapes or the like made from PVC, polyester, mylar (PET) and polyolefins such as polyethylene and polypropylene are all suitable, and further asserts that that each of these are taught as suitable electret backings by Applicants' specification. The Patent Office argues that such disclosure,

coupled with the admissions regarding the fact that the disclosed pressure sensitive adhesives are particularly suitable, is essentially all that is required to reject article claim 1.

Without agreeing to the Patent Office's characterization of WO '540, or admitting that the rejection is even proper, Applicants submit that as discussed hereinabove and in previous responses, the mere recitation of PVC, polyester, mylar (PET) or polyolefins such as polyethylene and polypropylene, in and of itself, is insufficient to inherently teach or properly suggest a cling backing. For example, characteristics of PVC cling films (e.g., plasticizer) are discussed in Applicants' prior Amendment dated 12/28/05. It is further submitted that there is no teaching, suggestion, or proper motivation in WO '540 to provide a PVC film that is formulated and formed into a cling film within the meaning of that term. Likewise, it is still further submitted that WO '540 is silent as to providing any of the recited polymers in an electrically charged form (e.g., an electret) that would inherently function as a cling backing. Applicants still further submit that to the extent that corona discharge is discussed in WO '540 (on page 8, line 2), it is for the purpose of removing the wax layer, and hence any resulting article (even assuming *arguendo* that electrical charge were imparted to it, and without admitting that such is the case) would not have a heat activatable adhesive.

Applicants respectfully submit that the disclosure in Applicants' specification of thermoplastic polymeric materials that can maintain an electret charge (e.g., on pages 7 and 8 of Applicants' specification) includes materials that can maintain an electret charge if one is imparted to the material. for example, according to a process such as one described in Applicants' specification on page 6 paragraph bridging page 7.

Claim 1 (and claims 29 and 53) is patentable for at least the reasons given above. Claims 2-3, 5, 6, 10, 11, 16, 17, 20, 24, and 25 each add additional feature(s) to patentable claim 1 and are likewise patentable.

In summary, the rejection of claims 1-3, 5, 6, 10, 11, 16, 17, 20, 24, and 25 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over WO '540 has been overcome and should be withdrawn.

§ 103 Rejections

Claims 4, 7, 9, 12-15, 18, 19, 21-23, 26-28, 32, 35, 37, 43-45, 48-51, 56, 59-61 and 64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shiba et al.

The Patent Office applies Shiba et al. substantially as set forth above and asserts that such parameters as the presence of cling vinyl, a semi-crystalline polymer heat activatable adhesive, the presence of an "auxiliary adhesive", presence of continuous and discontinuous adhesives, presence of image-receiving layers and graphic images, and the use of polypropylene and ionomers as compositions suitable for forming the cling backing are obvious modifications to one of ordinary skill in the absence of unexpected results.

Without agreeing to the Patent Office's characterization of Shiba et al., or admitting that the rejection is even proper, Applicants submit that claims 1, 29 and 56 are patentable over Shiba et al. for at least the reasons given hereinabove. Claims 4, 7, 9, 12-15, 18, 19, 21-23, 26-28, 32, 35, 37, 43-45, 48-51, 59-61 and 64 each add additional feature(s) to patentable claims and are likewise patentable.

In summary, the rejection of claims 4, 7, 9, 12-15, 18, 19, 21-23, 26-28, 32, 35, 37, 43-45, 48-51, 56, 59-61 and 64 under 35 U.S.C. § 103(a) as being obvious over Shiba et al. has been overcome and should be withdrawn.

Claims 4, 7-9, 12-15, 18, 19, 21-23 and 26-64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over WO '540.

The Patent Office applies WO '540 substantially as set forth above, with claims 29 and 53 not believed to be anticipated only because of an absence of the relatively conventional process steps of activating by heating the adhesive layer of the cling article. The Patent Office asserts that the remaining dependent claims not either expressly or inherently disclosed are each obvious modifications to one of ordinary skill, in the absence of unexpected results.

Without agreeing to the Patent Office's characterization of WO '540, or admitting that the rejection is even proper, Applicants submit that claims 1, 29, and 56 are patentable over WO '540

for at least the reasons given hereinabove. Claims 4, 7-9, 12-15, 18, 19, 21-23, 26-28, 30-55, and 57-64 each add additional feature(s) to patentable claims and are likewise patentable.

Hence, the rejection of claims 4, 7-9, 12-15, 18, 19, 21-23 and 26-64 under 35 U.S.C. § 103(a) as being obvious over WO '540 has been overcome and should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Respectfully submitted,

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Date

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